

### **REMARKS**

In the September 24, 2004 Office Action, the drawings and specification were objected to and claims 1, 6-13 and 15-27 stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

#### ***Clarification of the Status of Claim 28***

It is noted that claim 28 was not treated in the final Office Action. While claim 28 was listed as rejected in the Office Action Summary, no prior art was applied to claim 28 in the Office Action. Applicant respectfully requests clarification of the status of claim 28. Since no prior art was applied to claim 28, Applicant has assumed that the claim is considered allowable. Therefore, claim 28 has been incorporated into independent form.

It is further noted that claim 28 recites limitations similar to claim 8, which is believed to be allowable for the reasons set forth below.

Applicant respectfully requests entrance of this amendment and either allowance of claim 28 or a new Office Action treating claim 28 and restarting the response period.

#### ***Status of Claims and Amendments***

In response to the September 24, 2004 Office Action, Applicant has amended the claims as indicated above. Claim 1 has been cancelled without prejudice and claim 13 has been made into independent form. Thus, claims 6-13 and 15-28 are pending, with claims 8, 13 and 28 being the only independent claims. Reconsideration of the pending claims is respectfully requested in view of the above amendments and the following comments.

#### ***Rejections - 35 U.S.C. § 103***

In paragraph 2 of the Office Action, claims 1, 6, 7, 9-12, 17-21, 23, 26 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,012,236 (Pozzobon) in view of U.S. Patent No. 3,925,916 (Garbuio). In response, Applicant has

cancelled claim 1 as mentioned above. Dependent claims 6, 7, 9-12, 17-21, 23 and 26 now depend from independent claim 13.

In paragraph 3 of the Office Action, claims 8, 15, 16, 22, 24 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pozzobon in view of Garbuio and further in view of U.S. Patent No. 5,775,006 (Breuner).

Claim 8 recites, *inter alia*, a boot liner comprising an upper portion including a tightening device fixed thereto with a first strap portion overlying a part of the first banana-shaped pad and a second strap portion overlying a part of the second banana-shaped pad. This arrangement is not disclosed or suggested by the Pozzobon, Garbuio and Breuner combination or any other prior art of record.

Claim 8 requires that the tightening device be fixed to the upper portion. The upper portion is part of the *boot liner*. Claim 8 further requires that a strap portion overlie a part of the first banana-shaped pad and another strap portion overlie a part of the second banana-shaped pad. In contrast, the Breuner patent discloses yokes 26 and 28, which are fixed to the *boot* 12, 18 itself not the boot liner, as described at column 5, lines 7 and 8. Furthermore, Breuner does not disclose a first or second strap portion overlying a part of a banana-shaped pad located in an ankle section, as claim 8 requires. Rather, Breuner discloses straps 50, 52, 56 that are incapable of overlying a banana-shaped pad in an *ankle section*.

For at least the reasons above, Applicant respectfully requests that this rejection be withdrawn.

In addition, claim 28 includes limitations similar to claim 8. Applicant respectfully submits that claim 28 is allowable for at least the same reasons set forth above for claim 8.

In paragraph 4 of the Office Action, claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Pozzobon in view of Garbuio and further in view of U.S. Patent No. 5,746,015 (Clement et al).

Independent claim 13 recites, *inter alia*, a boot liner having an upper portion including a first banana-shaped pad located *in* the outer side of the ankle section and a second banana-shaped pad located *in* the inner side of the ankle section. Claim 13 further recites an inner layer disposed on an *interiorly* facing side of the thermoformable layer with the first and second banana-shaped pads located between the thermoformable and inner layers. This arrangement is not disclosed or suggested by the Pozzobon, Garbuio and Clement et al combination or any other prior art of record. It is well settled in U.S. patent law that the mere fact that the prior art can be modified does **not** make the modification obvious, unless the prior art **suggests** the desirability of the modification.

The Office Action cites Pozzobon as disclosing a boot liner having a thermoformable layer. The Office Action admits on page 2 that Pozzobon does not disclose a banana-shaped pad in a boot liner and looks to Garbuio to remedy this deficiency.

Garbuio illustrates a banana-shaped pad 8 in Figure 1. Under the Brief Description of the Drawing heading in Garbuio, Figure 1 is described as a sectional view of a **ski boot** lined with an insert. Figure 2 is described as an elevational view of the **insert without the boot**. Most importantly, Figure 2 does not show the banana-shaped pad 8. This is because the banana-shaped pad 8 is not part of the liner 2 at all. Rather, the banana-shaped pad 8 is separate from the liner 2 and, as described at column 2, line 29, is juxtaposed with the insert 2. That is, the banana-shaped pad 8 and the liner 2 are side by side. Not only is the banana-shaped pad 8 separate from the liner 2, but it is also *exteriorly* juxtaposed with the insert 2. This is in direct contradiction with claim 13, which requires a boot liner with an ankle section

having a first banana-shaped pad located *in* the outer side of the ankle section and a second banana-shaped pad located *in* the inner side of the ankle section as well as the banana-shaped pads between the thermoformable layer and the inner layer disposed on an *interiorly* facing side of the thermoformable layer.

The Office Action admits on pages 3 and 4 that Pozzobon and Garbuio do not disclose an upper portion including an inner layer disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located between the thermoformable layer and the inner layer. The Office Action looks to Clement et al to remedy this deficiency.

Clement et al discloses a boot liner having a wedging element 5 between an exterior wall 11 and an interior wall 12. Clement et al only speaks to an interior wall 12 and its application to the interior of a thermoplastic foam wedge 5. It does *not* disclose a banana-shaped pad between a thermoformable layer and an inner layer. Nor does Clement et al suggest modification of the banana-shaped pad of Garbuio, which is separate and exterior from the boot liner, such that it is part of the liner and interiorly placed. The addition of the Clement et al reference fails to give motivation to modify a banana-shaped pad separate and exterior from the a boot liner, as disclosed in Garbuio.

At best, the combination of Pozzobon, Garbuio and Clement et al discloses a liner having a thermoformable layer and an interior wall disposed on an interiorly facing side of the liner with a banana-shaped pad on the *exterior* of the liner. Dissimilarly, claim 13 requires a banana-shaped pad on the *interior* of the boot liner. That is, claim 13 states that the upper portion of the boot liner includes an inner layer disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located therebetween.

Accordingly, the prior art of record lacks any suggestion or expectation of success for combining the references to create the Applicant's unique arrangement of a first banana-shaped pad located *in* the ankle section and a second banana-shaped pad located *in* the ankle section and an inner layer disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located *therebetween*.

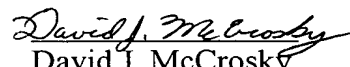
Moreover, Applicant believes that dependent claims 6, 7, 9-12 and 15-27 are also allowable over the prior art of record in that they depend from independent claims 8 and 13, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in independent claims 8 and 13, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments.

### ***Conclusion***

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-28 are now in condition for allowance. Reconsideration of the pending claims is respectfully requested.

Respectfully submitted,

  
David J. McCrosky  
Reg. No. 56,232

SHINJYU GLOBAL IP COUNSELORS, LLP  
1233 Twentieth Street, NW, Suite 700  
Washington, DC 20036  
(202)-293-0444

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